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| 09/775,548 | 02/05/2001 | Takayuki Fujikawa | SON-995/REISSUE | 9491 |

7590 06/18/2009
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| EXAMINER |
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MARC, MCDIEUNEL

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3664

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06/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAILED

JUN 18 2009

CENTRAL REEXAMINATION UNIT

In re Application of :
Takayuki Fujikawa et al. : ORDER TO
Application No. 09/775,548 : SHOW CAUSE
Filed: February 5, 2001 :
Practitioner Docket No.: SON-995/REISSUE :

This is a show cause order based on the expiration of U.S. Patent No. 5,870,527, for which patent the present application requests reissue.

BACKGROUND

1. Reissue application No. 09/775,548 ("the '548 reissue application") was filed on February 5, 2001, for reissue of U.S. Patent No. 5,870,527 ("the '527 patent") issued February 9, 1999.
2. The Image File Wrapper record for the '548 reissue application reveals that a paper titled "Response To Paper No. 17" was filed on December 29, 2003, and that the prosecution of the application is not closed.
3. The Office's financial records reveal that the 7.5 year maintenance fee for the '527 patent due by February 9, 2007 (the end of the maintenance fee grace period), was not paid.
4. The '527 patent expired at midnight on February 9, 2007, for failure to pay the 7.5 year maintenance fee due.¹ Notice of the expiration of the '527 patent for failure to pay the 7.5 year maintenance fee was published on April 10, 2007, in the *Official Gazette*.²

¹ See: MPEP § 2506, third paragraph.

² See: <http://www.uspto.gov/web/offices/com/sol/og/2007/week15/patexpi.htm>.

ORDER TO SHOW CAUSE

As pointed out above, the '548 reissue application is for reissue of the '527 patent, and the '527 patent has expired for failure to pay the 7.5 year maintenance fee. A notice of the expiration of the '527 patent was published in the *Official Gazette*. Because the '527 patent expired for failure to pay the second maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '527 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993). As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only 'for the unexpired part of the term of the original patent.' Thus, **when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority** because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; emphasis added]

Because the Director no longer has the authority under 35 U.S.C. § 251 to reissue the '527 patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the '548 reissue application to be an abandoned application.

Applicants are hereby provided with a period of **30 DAYS** from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.

If applicants propose to show cause why the present reissue proceeding should not be terminated, applicants' showing must include an explanation of why the proceeding should continue, in spite of the expiration of the original patent.

If applicants make a showing, the showing will be evaluated as to whether it provides sufficient basis as to why the present reissue proceeding should not be terminated. A failure to respond to this show cause order within the set 30-day period will result in the proceeding being terminated by default. If the present reissue proceeding is terminated, jurisdiction over the present application for reissue of the '527 patent will be returned to Technology Center Art Unit 3664 for processing as an abandoned application.

CONCLUSION

1. Applicants are hereby provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.
2. Failure by applicants to respond to this show cause order within the set 30-day period will result in termination of the present reissue proceeding by default, followed by a mailing of a Notice of Abandonment of the '548 reissue application.

3. Jurisdiction over the '548 reissue application is being retained by the Office of Patent Legal Administration, pending a response by the applicants, or the expiration of time for a response.
4. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

Robert A. Clarke

Robert A. Clarke

Director

Office of Patent Legal Administration

Office of the Deputy Commissioner

for Patent Examination Policy